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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/618,223

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Eric K. Mangiardi

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EXAMINER

LLOYD, EMILY M

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/618,223	Applicant(s) MANGIARDI ET AL.	
	Examiner EMILY M. LLOYD	Art Unit 3736	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Max Hindenburg/
 Supervisory Patent Examiner, Art Unit 3736

Emily M Lloyd
 Examiner
 Art Unit: 3736

Continuation of 11. does NOT place the application in condition for allowance because: Regarding Applicant's arguments regarding the 112 rejection of claims 5, 12 and 41, the Applicant argues that the term adjacent was used to describe legs that are flush to one another. However, stating that the legs are adjacent does not necessarily mean that the legs are in flush contact along the entire length as claimed. Applicant further argues that the only difference between the embodiments is that the distal ends of the legs are coupled together in Figures 14-18. However, since different language was used in the original disclosure to describe the configuration of the legs in the closed configuration for each embodiment, one can not presume that the flush contact in the first embodiment is implied in the second embodiment. In regards to the comments regarding Figure 18, it is respectfully submitted that one would need to see a cross-sectional view of the second embodiment in the closed configuration to determine if the legs are in flush contact.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Baxter-Jones teaches an exterior conduit that engages detents that coincide with measurement markings for the purpose of measuring the body. Claimed elements not taught by Baxter-Jones are provided in the other references discussed above. Additionally, the measurement indicators on the lumen facing surfaces was combined with the legs of Jain and Colvin et al., and as combined, the legs of Jain and Colvin et al. with measurement indicators (Doi) and detents (Baxter-Jones) would work with the indicator of Baxter-Jones.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivations were provided in the Final Office Action of 14 October 2008. The Examiner notes that Jain (which teaches measuring the diameter of a target segment) is modified by Colvin et al. and Haddock et al., then further modified by the measurement markers on the lumen facing surfaces of the legs as taught by Doi (which allow for measurement within a patient and for providing information regarding the diameter using an optical system), and then further modified by the outer conduit configured to engage measurement markers/detents as taught by Baxter-Jones (which would provide for releasably locking the elongated measurement member, or as combined with the other references, the legs). Further, the Examiner is unclear as to which motivations the application is arguing on pages 3 and 5 of the 11 December 2008 amendment, and it is unclear if Applicant is arguing the motivations for combining the references or what is taught by combining the references.

In response to applicant's arguments regarding specific properties of the various references (page 4 of Applicant's 11 December 2008 amendment), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that Jain, Baxter-Jones, and Baumann are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Jain and Baxter-Jones are both measuring devices for measuring parts of the body. Baumann is a further measuring and indicating device, and is relevant to prior art just like a gauge for measuring a non-body part is relevant in the art of measuring body parts.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's request for clarification regarding the statements regarding a lip protruding from the inner surface that is configured to engage the detents, the Examiner notes that despite the similarity in language, the Examiner notes that the limitation of "protruding from the inner surface" regarding the lip was not discussed with regards to the claims not rejected by Baumann. The surrounding language in the rejections with Baumann was provided for clarity as to the positioning and functioning of the lip with respect to other elements.

Regarding Applicant's arguments regarding Baumann, the Examiner notes that Baumann does teach that the distal end of the exterior conduit comprises a lip (57 in Figure 6 or 7) protruding from the inner surface that is configured to engage the detents (49 in Figure 6). The detents/notches 49 of Baumann are further aligned with length indicating means 49a (Figures 1 and 3, see also Column 4 lines 46-47). These indicating means provide a measurement as to the position of the end of wall 54.